APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,321	06/21/2005	Yutaka Ueda	05396/LH	1314

1933 7590 09/16/2008
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC
220 Fifth Avenue
16TH Floor
NEW YORK, NY 10001-7708

EXAMINER
JACKSON, STEVEN L

ART UNIT	PAPER NUMBER
4134	

MAIL DATE	DELIVERY MODE
09/16/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

		Application No.	Applicant(s)
Office Action Summary		10/540,321	UEDA ET AL.
		Examiner	Art Unit
		STEVEN L. JACKSON	4134

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>06/21/2005</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-13</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-13</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>06/21/2005</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>06/21/2005</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1.   Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention.

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

3.   The claims are generally narrative and indefinite, failing to conform to current U.S.

practice. They appear to be a literal translation into English from a foreign document and are

replete with grammatical and idiomatic errors.

Claim Rejections - 35 USC § 101

4.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

5.   Claims 1 - 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed

to non-statutory subject matter as follows.

Claims 1 - 2 define a computer program embodying functional descriptive

material. However, the claim does not define a "computer-readable medium or computer-

readable memory" and is thus non-statutory for that reason (i.e., "When functional

descriptive material is recorded on some computer-readable medium it becomes

structurally and functionally interrelated to the medium and will be statutory in most

cases since use of technology permits the function of the descriptive material to be realized" – Guidelines Annex IV). The scope of the presently claimed invention encompasses products that are not necessarily computer readable, and thus NOT able to impart any functionality of the recited program. The examiner suggests amending the claim(s) to embody the program on "computer-readable medium" or equivalent; assuming the specification does NOT define the computer readable medium as a "signal", "carrier wave", or "transmission medium" which are deemed non-statutory (refer to "note" below). Any amendment to the claim should be commensurate with its corresponding disclosure.

Claims 3 – 9 recite functional descriptive material on a computer readable medium. However, the program/algorithm itself merely manipulates data or an abstract idea, or merely solves a mathematical problem without a limitation to a practical application. A practical application exists if the *result* of the claimed invention is "useful, concrete and tangible" (with the emphasis on "result")(Guidelines, section IV.C.2.b). A "useful" result is one that satisfies the utility requirement of section 101, a "concrete" result is one that is "repeatable" or "predictable", and a "tangible" result is one that is "real", or has "real-world" value, as opposed to being "abstract" (Guidelines, section IV.C.2.b)). Claims 3 – 9 merely manipulates data without ever producing a useful, concrete and tangible result. Treating claims 3 - 9 as a whole, the claimed material is purely a program per se.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –(b) the invention was patented or described in a printed publication in
> this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application
> for patent in the United States.

7.   Claims 1 - 4 and 8 - 9 are rejected under 35 U.S.C. 102 (b) as being anticipated by US

Patent No. 5644444 to *Braithwaite et al.*

        As to claim 1, *Braithwaite et al* discloses a data recording program to control a

computer to function as a data recording terminal, comprising: an extracting section to

extract a write enable information section which shows permitting the writing of data

from an information recording medium (access a part of the content on a removable

medium which shows read/write protection is disabled); and a data writing section to

permit writing data to the information recording medium with which the write enable

information was recorded (permits the reading/writing of data to a medium on which

read/write protection is disabled). Refer to Figure 6A; Figure 6B; column 9, line 30 -

column 10 line 24. In particular, upon detecting insertion of a disk cartridge into a drive,

the microprocessor reads a part of the content on the medium within which is stored

read/write protection status (enabled to prohibit read/write functions or disabled to permit

read/write functions). If the read/write protection information section of the content on

the medium shows that read/write protection is disabled, normal operation (to include

reading from and writing to the medium) proceeds. It is inherent to the operation of the

disk drive as referenced above and described in *Braithwaite et al* that the processes are

tied to a computer program controlling the steps and logic of the operation.

As to claim 2, *Braithwaite et al* discloses a data recording program to control a computer to function as a data recording terminal, comprising: a write disable information extracting section to extract a write disable information which shows prohibiting the writing of data from an information recording medium (access a part of the content on a removable medium which shows read/write protection is enabled); a write disable release information extracting section to extract a write disable release information which shows to release the prohibit on writing of data from the information recording medium (changes read/write protection status of the medium from enabled to disabled); and a data writing section to prohibit writing data to the information recording medium with which the write disable information was recorded (prohibits the reading/writing of data to a medium on which read/write protection is enabled), and to permit writing data to the information recording medium with which the write disable release information was recorded (permits reading/writing data to a medium on which read/write protection is disabled). Refer to column 9, line 30 - column 12 line 7; Figure 6A; Figure 6B. In particular, upon detecting insertion of a disk cartridge into a drive, the microprocessor reads a part of the content on the medium within which is stored read/write protection information. If the read/write protection information section of the content on the medium shows that read/write protection is disabled, normal operation (to include reading from and writing to the medium) proceeds. If the read/write protection information section of the content on the medium shows that read/write protection is enabled, the microprocessor sets a flag prohibiting the reading/writing of data to/from the medium. If a change in the read/write protection status is commanded, the

microprocessor will go to step 120 (Figure 6B) to change the read/write protection status

of the medium. It is inherent to the operation of the disk drive as referenced above and

described in *Braithwaite et al* that the processes are tied to a computer program

controlling the steps and logic of the operation.

      As to claim 3, *Braithwaite et al* discloses an information recording medium (disk)

comprising: a write disable information including information which prohibit the writing

of data (read/write protection enabled status stored on the medium); and a write enable

information including information which permit the writing of data (read/write protection

disabled status stored on the medium). Refer to column 9, line 30 - column 10 line 24;

Figure 6A; Figure 6B.

      As to claim 4, *Braithwaite et al* discloses an information recording medium (disk)

comprising: a write disable information including information which prohibit the writing

of data (read/write protection enabled status stored on the medium); and a write disable

release information including information which release the prohibiting of writing of data

(change read/write protection status of the medium from enabled to disabled). Refer to

column 9, line 30 - column 12 line 7; Figure 6A; Figure 6B. Although *Braithwaite et al*

does not expressly disclose that the code executed to change the read/write protection

status of the medium is stored on the medium, the storage location of the code is merely a

design matter which can be appropriately selected by a person of skill in the art.

      As to claim 8, *Braithwaite et al* discloses a data recording system (computer)

comprising: a write enable information recording section to record a write enable

information which shows permitting the writing of data to an information recording

medium (writes read/write protection disabled status to medium); and a data writing

section to permit writing data to the information recording medium with which the write

enable information was recorded (read/write to a medium). Refer to column 9, line 30 -

column 10 line 24; Figure 6A; Figure 6B.

     As to claim 9, *Braithwaite et al* discloses a data recording system comprising: an

information recording medium having a write disable information which shows

prohibiting the writing of data (disk with read/write protection enabled); a write disable

release information recording section to record a write disable release information which

shows to release the prohibit on writing of data to the information recording medium

(change read/write protection status of the medium from enabled to disabled); and a data

writing section to prohibit writing data to the information recording medium with which

the write disable information was recorded (prohibits the reading/writing of data to the

medium in which read/write protection is enabled), and to permit writing data to the

information recording medium with which the write disable release information was

recorded (permits the reading/writing of data to the medium in which read/write

protection is disabled). Refer to column 9, line 30 - column 12 line 7; Figure 6A; Figure

6B.

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said invention pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

9.   Claims 5 – 6, and 11are rejected under 35 U.S.C. 103(a) as being unpatentable over US

Patent No. 5644444 to *Braithwaite et al* in view of US Patent No 6437933 B1 to *Sugiyama et al*.

As to claim 5, *Braithwaite et al* discloses a data recording terminal (computer)

record the data recorded in a first information recording medium into a second

information recording medium (writing data from a first recording medium onto a second

recording medium), comprising: a reading out section to read out the data from the first

information recording medium (reads/writes data from the equipment or a first recording

medium); an extracting section to extract a write enable information which shows

permitting the writing of data from the second information recording medium (access

read/write protection status of second recording medium); a data writing section to permit

writing data to the second information recording medium with which the write enable

information was recorded (reads/writes data to the second recording medium). Refer to

column 9, line 30 - column 10 line 24; column 4, lines 19 – 23; Figure 6A; Figure 6B;

where, the terminal is a computer with the disk drive as either a peripheral or an integral

member of the computer.

Braithwaite et al does not expressly disclose recording information from a first

recording medium into a second recording medium.

Sugiyama et al discloses a method of recording (dubbing) copyright information

from a first recording medium into a second recording medium. Refer to Figure 1;

column 3, line 40 - column 4, line 9.

Braithwaite et al and *Sugiyama et al* are analogous art because they are from the

same field of endeavor with respect to read/write protection of removable mediums.

At the time of the invention, it would have been obvious to a person of skill in the art to modify the process for copying information from a first recording medium to a second recording medium so that the read/write protection was recorded in both the first and second recording mediums and the recording/reproducing apparatus checked (or could change) the read/write protection status of both mediums before proceeding with copying information from the first recoding medium to the second recording medium. The suggestion/motivation would have been to protect the content of the first recording medium and determine if the user had adequate rights to copy information to the second recording medium protecting the rights of data on the first recording medium.

As to claim 6, *Braithwaite et al* discloses a data recording terminal record the data recorded in a first information recording medium into a second information recording medium (writing data from a first recording medium onto a second recording medium), comprising: a reading out section to read out the data from the first information recording medium (reads/writes data from the equipment or a first recording medium); a write disable information extracting section to extract a write disable information which shows prohibiting the writing of data from the second information recording medium (access read/write protection status of second recording medium); a write disable release information extracting section to extract a write disable release information which shows to release the prohibit on writing of data from the second information recording medium (change read/write protection status of the medium from enabled to disabled); and a data writing section to prohibit writing data to the second information recording medium with which the write disable information was recorded (prohibit the reading/writing of data

from the medium in which the read/write protection status is enabled), and to permit

writing data to the second information recording medium with which the write disable

release information was recorded (permit the reading/writing of data from the medium in

which the read/write protection status is disabled). Refer to column 9, line 30 - column

12 line 7; column 4, lines 19 – 23; Figure 6A; Figure 6B; where, the terminal is a

computer with the disk drive as either a peripheral or an integral member of the

computer.

     Braithwaite et al does not expressly disclose recording information from a first

recording medium into a second recording medium.

     Sugiyama et al discloses a method of recording (dubbing) copyright information

from a first recording medium into a second recording medium. Refer to Figure 1;

column 3, line 40 - column 4, line 9.

     Braithwaite et al and *Sugiyama et al* are analogous art because they are from the

same field of endeavor with respect to read/write protection of removable mediums.

     At the time of the invention, it would have been obvious to a person of skill in the

art to modify the process for copying information from a first recording medium to a

second recording medium so that the read/write protection was recorded in both the first

and second recording mediums and the recording/reproducing apparatus checked (or

could change) the read/write protection status of both mediums before proceeding with

copying information from the first recoding medium to the second recording medium.

The suggestion/motivation would have been to protect the content of the first recording

medium and determine if the user had adequate rights to copy information to the second

recording medium protecting the rights of data on the first recording medium.

As to claim 11, *Braithwaite et al* discloses a data recording method which record

the data recorded in a first information recording medium into a second information

recording medium (writing data from a first recording medium onto a second recording

medium), comprising steps of: recording a write enable information which shows

permitting the writing of data to the second information recording medium (writes

read/write protection status as disabled on second recording medium); extracting the

write enable information from the second information recording medium (access

read/write protection status of second recording medium), in a data recording terminal

(computer); reading the data recorded in the first information recording medium when the

write enable information is recorded on the second information recording medium (reads

data from first recording medium when write protection is disabled on second recording

medium); and writing the read data in the second information recording medium (write

data from first recording medium onto second recording medium). Refer to column 9,

line 30 - column 12 line 7; column 4, lines 19 – 23; Figure 6A; Figure 6B; where, the

terminal is a computer with the disk drive as either a peripheral or an integral member of

the computer. In particular, upon detecting insertion of a disk cartridge into a drive, the

microprocessor reads a part of the content on the medium within which is stored

read/write protection information. If the read/write protection information section of the

content on the medium shows that read/write protection is disabled, normal operation (to

include reading from and writing to the medium) proceeds.

Braithwaite et al does not expressly disclose recording information from a first recording medium into a second recording medium.

Sugiyama et al discloses a method of recording (dubbing) copyright information from a first recording medium into a second recording medium. Refer to Figure 1; column 3, line 40 - column 4, line 9.

Braithwaite et al and *Sugiyama et al* are analogous art because they are from the same field of endeavor with respect to read/write protection of removable mediums.

At the time of the invention, it would have been obvious to a person of skill in the art to modify the process for copying information from a first recording medium to a second recording medium so that the read/write protection was recorded in both the first and second recording mediums and the recording/reproducing apparatus checked (or could change) the read/write protection status of both mediums before proceeding with copying information from the first recoding medium to the second recording medium. The suggestion/motivation would have been to protect the content of the first recording medium and determine if the user had adequate rights to copy information to the second recording medium protecting the rights of data on the first recording medium.

10.   Claims 7, 10, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5644444 to *Braithwaite et al*.

As to claim 7, *Braithwaite et al* further discloses a data recording terminal as recited in the parent claim, wherein the first recording medium is an information recording medium (disk) which can be detached and attached to apparatus (via a disk drive). Refer to column 9, line 30 - column 10 line 24; Figure 6A; Figure 6B.

Braithwaite et al does not expressly disclose the data transferred as image data of photographs.

It would have been well known to a person of ordinary skill in the art at the time of the invention that image data of photographs is a form of data storable on removable mediums. Specifying image data as the data on the removable medium to be used in claim 7 is an obvious variant of the data on the removable medium as disclosed in *Braithwaite et al.*

As to claim 10, *Braithwaite et al* further discloses a data recording system as recited in the parent claims comprising: an information recording terminal (computer) to record at least one of the write enable information and a write disable release information to the information recording medium; and a data recording terminal (computer) having the data writing section. Refer to column 9, line 30 - column 12 line 7; column 4, lines 19 – 23; Figure 6A; Figure 6B; where, the terminal is a computer with the disk drive as either a peripheral or an integral member of the computer.

Braithwaite et al does not expressly disclose an exhibiting section to exhibit information recording mediums on shop shelves.

Exhibiting items on shop shelves is, however, a business method which is well known to the general public.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use a method of exhibiting recording mediums of the type disclosed in *Braithwaite et al* on shop shelves. The suggestion/motivation would have been to display

the recording mediums to potential consumers and to allow the potential consumer easy access to the recording mediums.

As to claim 12, *Braithwaite et al* discloses a data recording method which record the data recorded in a first information recording medium into a second information recording medium (writing data from a first recording medium onto a second recording medium), comprising steps of: recording the write disable release information which shows that the prohibit on the writing of the data based on the write disable information was released to the second information recording medium (change read/write protection status of the medium from enabled to disabled); extracting the write disable information from the second information recording medium (access read/write protection status of second recording medium), in a data recording terminal (computer); extracting the write disable release information from the second information recording medium, in a data recording terminal (change read/write protection status of the medium from enabled to disabled); prohibiting the writing of data when the write disable information is recorded on the second information recording medium (prohibit the reading/writing of data from the medium in which the read/write protection status is enabled); permitting the writing of data when the write disable release information is recorded on the second information recording (permit the reading/writing of data from the medium in which the read/write protection status is disabled); reading the data recorded in the first information recording medium based on judgment of prohibition or permission (read/write data from an equipment or a first information recording medium); writing the read data in the second information recording medium (read/write data to the second recording medium). Refer

to column 9, line 30 - column 12 line 7; column 4, lines 19 – 23; Figure 6A; Figure 6B;

where, the terminal is a computer with the disk drive as either a peripheral or an integral

member of the computer. In particular, upon detecting insertion of a disk cartridge into a

drive, the microprocessor reads a part of the content on the medium within which is

stored read/write protection information. If the read/write protection information section

of the content on the medium shows that read/write protection is disabled, normal

operation (to include reading from and writing to the medium) proceeds.

Braithwaite et al does not expressly disclose recording information from a first

recording medium into a second recording medium.

In accordance with the court's decision in St. Regis Paper Co. v. Bemis Co., Inc.,

the mere combination of two recording mediums of the type disclosed in Braithwaite et

al acting independently is an obvious alternative to the invention disclosed in Braithwaite

et al.

In view of the court's decision in St. Regis Paper Co. v. Bemis Co., Inc., claim 12

is rejected because both the first and second information recording mediums can be of the

type disclosed in Braithwaite et al. At the time of the invention, it would have been

obvious to a person of skill in the art to use two recording mediums with read/write

protection in the process of transferring data from one recording medium to another.

There is no added functionality to the system as a whole by the combination of the two

recording mediums. Two recording mediums as disclosed in Braithwaite et al would go

through the process as set forth in claim 12 when the two mediums were acting

independently of one another to transfer data from one to the other as set forth in Figure

6A; Figure 6B; column 9, line 30 - column 12 line 7; column 4, lines 19 – 23; of

Braithwaite et al. The arrangement of steps in the recording process from one recording

medium to a second recording medium is merely a design matter which can be

appropriately selected by a person of skill in the art. The motivation to combine two

recording mediums of the type disclosed in *Braithwaite et al* is the same as used in the

rejection of claim 5.

> *Braithwaite et al* does not expressly disclose an exhibiting section to exhibit

information recording mediums on shop shelves.

> Exhibiting items on shop shelves is, however, a business method which is well

known to the general public.

> At the time of the invention, it would have been obvious to a person of ordinary

skill in the art to use a method of exhibiting recording mediums of the type disclosed in

Braithwaite et al on shop shelves. The suggestion/motivation would have been to display

the recording mediums to potential consumers and to allow the potential consumer easy

access to the recording mediums.

> As to claim 13, *Braithwaite et al* further discloses a data recording terminal as

recited in the parent claim, wherein the first recording medium is an information

recording medium (disk) which can be detached and attached to apparatus (via a disk

drive). Refer to column 9, line 30 - column 10 line 24; Figure 6A; Figure 6B.

> *Braithwaite et al* does not expressly disclose the data transferred as image data of

photographs.

It would have been well known to a person of ordinary skill in the art at the time

of the invention that image data of photographs is a form of data storable on removable

mediums. Specifying image data as the data on the removable medium to be used in

claim 13 is an obvious variant of the data on the removable medium as disclosed in

Braithwaite et al.

Conclusion

11.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

US Patent No 5857021 to *Kataoka et al* describes a means of protecting information

stored in portable storage mediums by checking for the presence of identifiers assigned to each

mediums, systems, or terminals prior to allowing read/write access by a user.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to STEVEN L. JACKSON whose telephone number is (571) 270-

7364. The examiner can normally be reached on Monday through Friday, 8:00 AM until 5:00

PM, alternate Fridays, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Lun-Yi Lao can be reached on (571) 272-7671. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/STEVEN L JACKSON/

Examiner, Art Unit 4134

/LUN-YI LAO/

Supervisory Patent Examiner, Art Unit 4134